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— REMARKS —

Claims 1-12 have been cancelled. Applicants request withdrawal of the rejections to claims 1-12.

Claims 13-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of DeCarbon.

For this 103(a) rejection to stand, each and every element of the claims must be taught or suggested by the references, alone or in combination. Because the references, alone or in combination, do not teach or suggest the elements of the independent claims, as described above, the 103(a) rejections must fall.

Specifically, neither Watanabe, nor DeCarbon, alone or in combination, teach or suggest an actuating pin as claimed in claim 13. The Examiner likens the *pushrod* 30 of Watanabe to the actuating pin 106 of the instant application. However, a review of Watanabe indicates that the two structures are not similar. Watanabe teaches, at column 4, lines 14-18:

“Pushrod 30 passes through o-ring seal 32 which prevents working fluid from entering bore 82 in which the fluid motor is housed. Pushrod 30 also passes through sleeve 34 which has the function of retaining push rod o-ring seal 32.” This is in direct contrast to the structure disclosed in the instant specification, and claimed in claim 13. The claimed actuating pin 106 is illustrated in FIG. 3 (reproduced below) and clearly does not pass through an o-ring seal, nor pass through a sleeve.

Indeed, Watanabe teaches that a preferred embodiment of the pushrod 30 is integral with the piston 78. *See*, Watanabe, column 4, lines 11-14. Were the instant application modified in the fashion suggested by Watanabe, the invention simply would not work, and at the least, a very significant redesign would be necessary. Modifying the Watanabe damper as suggested by the Examiner would require significant modification to the Applicants' invention and would require significant redesign – a requirement in direct contrast to the mandates of Section 103(a). *See, In Re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

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Likewise, DeCarbon teaches an actuating member 21 that is elongated and u-shaped in cross-section. The DeCarbon actuating member 21 further extends through a u-shaped recess in a metal plate, allowing the actuating member 21 to move axially in the direction of the axis of a hollow rod. See, DeCarbon column 4, lines 30-36. Clearly, the actuating member 21 is a far cry from the actuating pin of the instant invention.

Furthermore, the mere fact that the references *could* be combined to arrive at the claimed invention (which Applicants do not concede and actively dispute) is insufficient to prove a prima facie case. See MPEP 2143.01, *In Re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) and *In Re Fritch*, 972 F.2d 1260, 23 USPQ.2d 1780 (Fed. Cir. 1992). While Applicants do not agree that the combination of the references would result in the claimed invention, nonetheless, there must be some motivation or suggestion in the references to combine to support a prima facie case of obviousness. In the absence of any such motivation or suggestion, the rejection must fail.

Additionally, as described in the Graham case, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. See *Graham v. John Deere Co.*, 383 U.S. 1 (1965). In this case, the Examiner appears to have engaged in impermissible hindsight, as there is a void of evidence around the Examiner's allegation of obviousness.

New claims 20-23 are patentable over the prior art because the prior art, alone or in combination fails to disclose, teach, or suggest each and every limitation of claimed elements.

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SUMMARY

This application is now believed to be in condition for allowance, and such action is respectfully requested. The Examiner is invited to telephone the undersigned with any remaining issues.

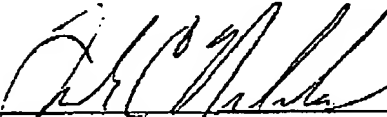
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Respectfully submitted,
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